

claim language is inconsistent with the specification, but rather whether the “claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994) (quoting *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*). Moreover, as expressed in the MPEP, it is a long-standing tenet of patent law that word for word support in the specification is not required for satisfying §112(2). Accordingly, the Examiner’s argument in support of the §112(2) rejection is misplaced because it applies the wrong test and because the rationale in support thereof contradicts the law under §112(2).

More particularly, the Examiner has raised only one argument in support of the §112(2) rejection and Applicant submits that this argument is erroneous. The Office Action contends that the claim term “one or more bays” (*e.g.*, claims 1 and 19) is not present in the detailed description or in the Figures (and only used to describe a portion of the prior art). On the contrary, the specification expressly describes a reticle sorter that includes “one or more bays each capable of holding a cassette having slots for reticles.” See page 2, lines 24-25. The language of the specification is therefore precisely consistent with the language of claims 1 and 19.

The specification further describes the reticle sorter as including “one or more docking locations 310 each capable of holding a cassette 320 having slots for reticles 324.” See page 5, lines 24-25. Also, Figure 3 illustrates a reticle sorter with two bays (*a.k.a.*, docking locations), each bay holding a cassette having slots for reticles. Clearly, the word “bay” is used to describe an area of the reticle sorter in one location of the specification (page 2, lines 24-25), and the phrase “docking location” is used to describe the same area in another location of the specification (page 4, lines 24-25); it would be plainly apparent to the skilled artisan that the specification uses the terms “bay” and the phrase “docking location” interchangeably and synonymously to describe an area of the reticle sorter that holds a cassette with slots for reticles. Indeed, no other interpretation would be tolerated or even recognizable. Therefore, while word-for-word support is not even a requirement under §112(2), the claim term “one or more bays” is expressly present in the specification.

The Examiner has also alleged that the clarity requirement of §112(2) is not satisfied because the claim term “bays” is included only in Applicant’s discussion of a prior-art semiconductor-handling facility. This statement is incorrect. As previously discussed in the

preceding paragraph, the specification describes the reticle sorter as including “one or more bays each capable of holding a cassette having slots for reticles” (page 2, lines 24-25). Moreover, the skilled artisan would recognize that the claim term “bays” is associated with Applicant’s invention and not the prior art; clearly, the term is in the claim for the purpose of describing Applicant’s invention and not the prior art. Therefore, the “claim reasonably apprises those of skill in the art of its scope.”

Accordingly, the only rationale proffered to support the §112(2) rejection is based on the wrong facts and the wrong law. Under the proper test, the requirements for satisfying §112(2) have been met and the rejection should, therefore, be withdrawn.

With respect to the rejection under §112(1), according to the Examiner, the lack of a proper description for the “bay” feature of claims 1 and 19 renders the disclosure non-enabling because it is not commensurate in scope with the claim language. Applicant respectfully submits that this rejection should also be removed because it is based on erroneous facts, as discussed above. Further, the rejection is based on the incorrect test. The correct test for enablement under 35 U.S.C. §112(1) is not whether the claim language is inconsistent with the specification, but rather whether the specification teaches those skilled in the art how to make the claimed invention without undue experimentation. *See, e.g., In re Ziegler, 992 F.2d 1197* (Fed. Cir. 1993). As explained by the Federal Circuit in this decision, *In re Ziegler*, “Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples.” Applicant submits that the requirements for satisfying §112(1) have been met because the specification teaches those skilled in the art how to make the claimed invention without any experimentation; that Office Action has not alleged otherwise.

Applicant submits that the independent claims 1 and 19 comply with §112. Because claims 2-4 and 6-12 depend directly or indirectly on independent claim 1, include the features recited in the independent claim on which they depend, as well as additional features, Applicant respectfully submits that claims 2-4 and 6-12 also comply with §112.


In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining

issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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